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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,428	11/21/2001	Noboru Iwata	49443DIV (70904)	4238
21874	7590	01/10/2005	EXAMINER	
EDWARDS & ANGELL, LLP			BERNATZ, KEVIN M	
P.O. BOX 55874			ART UNIT	
BOSTON, MA 02205			PAPER NUMBER	

1773

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/990,428	Applicant(s) IWATA ET AL.	
	Examiner Kevin M Bernatz	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-25 is/are pending in the application.
- 4a) Of the above claim(s) 17 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 18 and 20-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>01072005</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Amendment

1. Amendments to claims 18 and 23 - 25, filed on October 19, 2004, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

3. The drawings were received on October 19, 2004. These drawings are accepted.

Claim Rejections - 35 USC § 102

4. Claims 18 and 20 - 25 are rejected under 35 U.S.C. 102(a) as being anticipated by Aratani (WO99/39342) as evidenced by applicants' admissions for the reasons of record as set forth in Paragraph No. 9 of the Office Action mailed on July 19, 2004. See U.S. Patent No. 6,572,957 B1) which is the U.S. equivalent of WO '342.

Claim Rejections - 35 USC § 103

5. Claims 18, 20, 21 and 23 - 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii et al. (U.S. Patent No. 6,249,489 B1) in view of Aratani (WO '342) and as evidenced by applicants' admissions for the reasons of record as set forth in Paragraph No. 10 of the Office Action mailed on July 19, 2004.

Response to Arguments

6. The rejection of claims 18 and 20 - 25 under 35 U.S.C § 102(a) – Aratani

Applicant(s) argue(s) that Aratani must possess four magnetic layers, which therefore does not read on the claimed three magnetic layers of the present invention since the DS layer of Aratani cannot correspond to the claimed first magnetic layer (*pages 11 – 14 of response*). Applicants further argue that the Examiner has erred in the interpretation of the Aratani reference (*page 12 of response*). The examiner respectfully disagrees.

First, the Examiner notes that the present claims are open to additional layers being present and applicants are suggested to positively recite that the magnetic layers are directly disposed on each other or exclude additional magnetic layers in a similar, supported, fashion. Regarding the argument that the relied upon layer in Aratani can't meet the limitation of the "first magnetic layer is composed so as to be characterized ... to restrict movement of a domain wall located beyond the light beam spot rear part", the Examiner notes that this limitation is a functional limitation and, provided the function is met, the limitation will be met. The Examiner notes that the relied upon DS layer *has a*

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composition (i.e. any composition) and the domain wall located beyond the light beam rear spot is restricted in its movement (albeit by the interaction with the YS layer), hence the DS layer must be “composed so as to be characterized ... to restrict movement of a domain wall located beyond the light beam spot rear part”, since the domain wall located out of the light beam rear spot *is* restricted in it’s movement in the DS layer.

Regarding the alleged mischaracterization of the Aratani reference, the Examiner notes that the relied upon sections describe the Aratani layers which are comparable to the layers used in the prior art, *as well as the novel YS layer taught by Aratani*. The Examiner suggests applicants re-read the relied upon sections in view of the rejections of record, since the Examiner deems the cited notations are correct.

7. The rejection of claims 18, 20, 21 and 23 - 25 under 35 U.S.C § 103(a) – Fujii et al. in view of Aratani

Applicant(s) argue(s) that the combination of Aratani with Fujii et al. meets the deficiencies mentioned above and that the insertion of the YS layer into the Fujii et al. invention would not yield the claimed invention (*pages 15 – 18 of response*). The examiner respectfully disagrees.

First, the Examiner notes that applicants’ claims are open to additional layers as commented on above. Second, the Examiner notes that Aratani et al. was not relied upon to teach the insertion of the YS layer, but merely to teach the equivalent functional use of the orientation of the read-out/reproducing film below the recording temperature.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

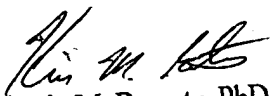
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB
January 7, 2005


Kevin M. Bernatz, PhD
Primary Examiner